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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/458,415

Filing Date: December 10, 1999

Appellant(s): GILLESPIE, KEVIN

Timothy A. French
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed November 25, 2002.

(I) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-8 and 47-76 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,092,251	Tomat	7-2000
6,176,025	Patterson et al.	1-2001
5,875,568	Lennihan, Jr.	3-1999
Des. 417,946	Turner	12-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomat 6,092,251. Tomat '251 discloses all the limitations of the claims including the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Patterson et al. 6,176,025. The reference as applied to claim 1 above discloses all the limitations of the claims except for the inner member containing liquid or air. Patterson et al. '025 teaches that a cushion used in cushioning the heel of a user's foot while in a shoe can be made of a bladder-like material that contains air, gel, or any fluid to aid in distributing the impact forces of the user's foot with the ground. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made, to make the inner member of the reference as applied to claim 1 above out of a bladder containing air, liquid, or gel, as taught by Patterson et al. '025, to aid in cushioning the impact of the user's foot with the ground and to better distribute the impact over the user's foot during the gait cycle.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Lennihan, Jr. 5,875,568. The reference as applied to claim 1 above discloses all the limitations of the claim except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of the reference as applied to claim 1 above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by

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Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

6. Claims 47, 49-59, 61-65 and 67-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Turner Des. 417,946. Tomat '251 discloses all the limitations substantially as claimed including the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-2). Tomat '251 does not teach the use of grooves and ridges. Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer sole (as seen in Figure 3, the ride up the side of the sole) and extend to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

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7. Claims 60, 66, 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Tomat 6,092,251 in view of Turner Des. 417,946 as applied above further in view of Lennihan, Jr. 5,875,568. Tomat '251 in view of Turner '946 discloses substantially all the limitations of the claims as noted above except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of Tomat '251 in view of Turner '946 as applied above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Turner Des. 417,946 and Lennihan, Jr. 5,875,568. Tomat '251 discloses the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region an including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA, or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figure 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and

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intermediate member 11 can be a single component (see col. 2, lines 50-2). Tomat '251 does not teach the use of grooves and ridges or the smooth transition of the back wall of the outer member from a horizontal plane to a vertical plane.

Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer sole (as seen in Figure 3, the ride up the side of the sole) and extend to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (See Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make back wall of the outer member of Tomat '251 in view of Turner '946 as applied above rounded so that it smoothly transitioned between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

9. Claim 76 is rejected under 35 U.S.C. 103(a) as being obvious over Tomat 6,092,251 as applied to claim 1 above. Tomat '251 as applied to claim 1 above discloses all the limitations of the claim except for the inner member being a softer durometer than the intermediate member. It is well-known in the art of feet cushions that the area of greatest impact, i.e. the heel area, should be made of a softer

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material than the other cushioning areas since it take the brunt of the impact of the user's foot. This would allow for appropriate cushioning of the heel without impacting the other areas of the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the heel member of Tomat '251 softer than the intermediate member to allow for better cushioning of the heel without detracting from support of the arch and metatarsal areas of the foot.

(II) Response to Argument

For simplicity and easier understanding of the responses to the arguments, the responses below will be numbered and lettered to correspond with appellant's arguments.

(8)

A. Response to arguments that Tomat does not anticipate the limitations of Claims 1 and 4-7

1.) Appellant's first argument appears to be that the reference to Tomat does not teach or suggest a baby shoe or an outsole for a baby shoe. This argument is not clearly understood. The claims of the application clearly recites either of the following "A shoe outsole for a baby shoe,..." (emphasis added) and "The shoe outsole..." in the first line of the preamble of the claim. The preambular limitation of a baby shoe is only a statement of preferred or intended use of the sole. There is no structure or any other recitation in the body of the claim that would give life, scope or meaning to the preambular recitation of a baby shoe. Since shoes are typically made of different lengths, widths or sizes, it would be obvious to one of ordinary skill in the art to make the sole of Tomat in the sizes necessary to fit a multitude of different sized feet. Since all the other structural limitations of the claims are met by the Tomat reference, the reference must be used as prior art against the claimed invention. With respect to the Declaration by David Thorpe, this declaration does not aid in clearing the fact that the intended use statement "for a baby shoe" does not positively recite any structural limitation to the sole that is different than that of Tomat.

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2.) Appellant's second argument appears to be that the intermediate member 11 in the forward area of Tomat is not an intermediate member as claimed by the appellant. This argument is also not clearly understood. Member 11 in the forward area of Tomat is located between the outer surface of outer member 4 and inner member 11 located in the heel region of the shoe of Tomat. As seen in Figure 2, the outer member 4 is located in the toe area and encircles both members 11, the heel member 11 being the inner member and the forward member 11 being the intermediate member. The forward member 11 is located between the outer member 4 located in the toe area of the sole and the inner member 11 located in the heel area of the sole, as the intermediate member 11 is located in the forward area of the sole which is located between the toe and heel of the sole. Therefore, looking from the toe of the sole to the heel of the sole, one would see the outer member 4, the intermediate member 11, more of the outer member 4, inner member 11 in the heel, and the more of the outer layer 4. Since the intermediate layer 11 in the forward portion of the sole is located between the outer layer 4 and inner layer 11 in the heel, it would therefore meet the limitations of the claims (see attached marked-up copy of figure 2 for reference). With regard to appellant's arguments that, in the embodiment that the two members 11 can be made as a single component, the single component, therefore, cannot be both and intermediate and inner member, this argument is not clearly understood. The members would be located in the same positions as currently located in Figure 2 except the outer portion 4 located between the two portions 11 would be eliminated. Therefore, the outer member at the toes and the inner member, that portion of the combined 11 at the heel) would still have the intermediate member, that portion of the combined 11 at the forefoot area, located between them.

B. Response to Arguments that claims 2 and 3 are not obvious under 35 U.S.C. 103(a) over Tomat in view of Patterson

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Applicant argues that Patterson does not supply that which is lacking in Tomat and Patterson does not teach or suggest a baby shoe. See (11)(8) A paragraphs 1 and 2 above for arguments relating to Tomat and the limitation of the intended use statement “for a baby shoe”.

C. Response to Arguments that claim 8 Is not obvious under 35 U.S.C. 103(a) as being unpatentable over Tomat in view of Lennihan, Jr.

Applicant argues that Lennihan, Jr. does not supply that which is lacking in Tomat and Patterson does not teach or suggest a baby shoe. See (11)(8) A paragraphs 1 and 2 above for arguments relating to Tomat and the limitation of the intended use statement “for a baby shoe”.

D. Response to Arguments that claims 47, 49-59, 61-65 and 67-73 are not obvious under 35 U.S.C. 103(a) over Tomat in view of Turner.

Appellant argues that the sole of Tomat does not have the flexibility required for a baby shoe. This argument is not clearly understood. The limitations in the claims are silent as to any flexibility of the sole and therefore, Tomat meets the claimed structure of the invention. With respect to appellant’s arguments directed to the “baby shoe”, see (11)(8) A paragraphs 1 and 2 above for arguments relating to Tomat and the limitation of the intended use statement “for a baby shoe”. Appellant further argues that turner does not teach or disclose a “baby shoe”. This argument is not clearly understood for the same reasons as stated in (11)(8) A paragraphs 1 and 2 above for arguments relating to Tomat and the limitation of the intended use statement “for a baby shoe”. With respect to appellant’s arguments that Tomat fails to disclose an intermediate member and turner fails to rectify this deficiency, see (11)(8) A paragraph 2 for arguments directed to the Tomat reference meeting this limitation. With respect to appellant’s arguments that claims 49-59 require that the upper forefoot region have grooves and neither Tomat nor Turner disclose grooves in the upper forefoot region, it appears that appellant is arguing

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more than that which is claimed. It appears that appellant is arguing that the upper surface of the forefoot region contains grooves, whereas the claims only require that an upper forefoot region have grooves. As noted in paragraph 7 of the Final Office action, page 4, line 13 of paragraph 7 through page 5, line 5, Turner show grooves located on the upper forefoot region of the sole which includes the upper surface of the sole.

E. Response to Arguments that claims 60, 66, 74, and 75 are not obvious under 35 U.S.C.

103(a) over Tomat in view of turner and further in view of Lennihan, Jr.

Appellant argues that none of the references disclose a “baby shoe” or an intermediate member located between the inner member and the outer member. See (11)(8) A paragraphs 1 and 2 above for arguments relating to these issues.

F. Response to arguments the claim 48 is not obvious under 35 U.S.C. 103(a) over Tomat in

further view of turner and Lennihan, Jr.

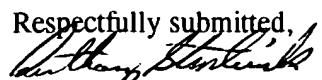
Appellant argues that none of the references discloses a “baby shoe” and that none of the references disclose the grooves located in the upper forefoot region. See (11)(8)A paragraphs 1 and 2 as well as the response to D above for arguments relating to these issues.

G. Response to arguments that Claim 76 is not obvious under 35 U.S.C. 103(a) over Tomat

Appellant argues that Tomat does not disclose an intermediate member as claimed. Please see (11)(8)a paragraph 2 above for arguments relating to this issue.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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February 6, 2003

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